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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,542	06/06/2001	Ruk Peterson	LEH-33	6908

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01/29/2004

EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,542

Applicant(s)

PETERSON ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original specification for a "metatarsal guard having no slits therein" as now claimed in claim 4. MPEP 2173.05 (i) requires that "Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement". Since there is no reference to "slits" or the absence thereof in the original specification it is not clear what structures applicant intends to exclude/encompass with such language.

3. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4 the phrase "guard having no slits therein" is confusing, and indefinite because nowhere in the original specification has such language been used and therefore the structural limitations applicant intends to encompass with such language is unclear.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fortin (5457898).

Fortin shows a shoe comprising a sole (12), a toe cap (15), an upper (14), and a metatarsal guard (11) with a convex arch/instep portion (shown in figure 1), and a single right and complementary left leg (side portion which lead to the edge 13) as claimed. In reference to the limitations of "only a single", Fortin clearly shows a "single leg", the rear portion of the sides shown in the figures, the front elements could be considered to be a "brace" or forward support. In reference to the limitation of "said convex arch portion having a section immediately rearward of the support legs which does not bear against the sole, Fortin clearly shows such at the location of the arrow from number 10 in figure 2. In reference to the limitations of "having no slits therein", the guard of Fortin does not contain any slits within the interior of the periphery of the guard, i.e. the actual guard is a solid piece of material with not slits or holes within the device, and since there is no basis or guidance in the original specification for limitations on "slits", i.e. there is no guidance as to what structural limitations applicant is intending to encompass with such language this broad interpretation is appropriate. In reference to a "lip", elements 16

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are considered to be a lip which overlap the toe cap but which do not contact/bear on the sole as claimed.

3. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Krajcir (4908963).

Krajcir shows a shoe with a toe cap (8), sole (5-7), and a metatarsal guard (figure 2b) which has a single concave right support leg (formed by 10, 11, and 14), and a single left support leg (formed by 10, 11, and 14), both legs show a section immediately rearward of the support legs which does not bear against the sole (clearly shown in figure 2b), a lip (front element 10) which overlies the toe cap (see figure 1) and the front element since it does bear on the toe cap which is located on top of the sole, the element 10 cannot bear on the sole because it is bearing on the toe cap which is above the sole, also figure 1 clearly shows that the front element 10 is located slightly elevated above the sole whereas the rear portions 11 and 14 do bear on the sole (as shown in figure 1) as claimed. In reference to the limitation of "said metatarsal guard having no slits", the guard of Karjcir is shown in figure 2b without slits of any type, and since there is no guidance in the specification as to what structural limitations applicant is intending to encompass with such language this broad interpretation is appropriate.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortin.

If applicant argues that the guard of Fortin contains "slits" and multiple legs, it has been held that omission of an element and its function in combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 135 USPQ 184. It would have been obvious to remove the flexibility elements/cuts (19 and 20) from the guard of Fortin to provide a stronger, stiffer, less expensive guard and shoe.

Response to Arguments

1. Applicant's arguments filed 12/24/03 have been fully considered but they are not persuasive.

In response to applicants arguments directed towards the limitation of "no slits", there is no basis for such a limitation in the original specification and since there is no guidance as to what structures applicant intends to encompass with such language a broad interpretation of this language has been used as noted above in the rejections.

In response to applicants' arguments directed towards the limitations of the "lip", these have been addressed above in the rejections.

In response to applicants' arguments directed towards the 103 rejection, the guard of Fortin if modified by omitting the elements/cuts/slits and their function, i.e. their increased flexibility, the remaining structures would clearly still perform their function of protecting the metatarsal area and providing safety to the wearers' foot.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner _____ of Art Unit _____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

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If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728